

REMARKS:

Claims 1, 2, 4 –7, 9-11, 13 and 17-21 are pending and stand rejected.

In claim 1, a concentration range was added to more specifically define the solubility/dispersibility. This amendment is supported by original disclosure at page 10, line 7 of the Substitute Specification.

Claim 1 has also been amended to include some or all of the limitations of claims 5 and 6. claims 5 and 6 have been cancelled without prejudice.

Claim 1 was further amended to include limitations on M2. This amendment is supported by original disclosure at page 6, lines 27-33 of the Substitute Specification.

Claim 7 was amended to cite the polymer from claim 1.

It is believed that no new matter has been added by any amendments.

35 U.S.C. §§ 102 and 103(a)

Matyjaszewski

Claims 1, 2, 4-6, 13, 18 and 21 stand rejected under 35 U.S.C. §102(b) or in the alternative under 35 U.S.C. §103(a) as being anticipated by or obvious over Matyjaszewski et al. J. Phys. Org. Chem., 2000, 13, p. 775-786. The Matyjaszewski reference fails to teach or suggest all of Applicant's claim elements, thus fails to provide a *prima facie* case of anticipation. Specifically, the Matyjaszewski reference fails to teach or suggest that the copolymer have one monomer being hydrophilic; nor that the resulting copolymer is soluble or dispersible in both water and organic solvent.

The Matyjaszewski reference discloses gradient copolymers – including the styrene acrylonitrile example on page 783, Figure 3. However, neither styrene nor acrylonitrile is a hydrophilic monomer, thus fails to meet that claim element. The Matyjaszewski reference does disclose the use of nitroxide-mediated controlled radical polymerization (p 779), and provides a list of monomers copolymerizable with styrene – a few being hydrophilic, but none being even generally from the list of Applicant's amended claims. The Matyjaszewski reference is silent on requiring a hydrophilic monomer, and is silent on the level of hydrophilic monomer that must be present – except that every example in the Matyjaszewski reference contains ZERO hydrophilic monomer. One of ordinary skill in the art would find no

motivation in the Matyjaszewski reference to even try to produce a gradient copolymer having at least 5% by weight of hydrophilic monomers selected from Applicant's amended claims – but would find in the Examples (no hydrophilic monomer in any) and silence regarding hydrophilicity/hydrophobicity a teaching away from Applicant's claims.

The Examiner's argument of solubility of the gradient copolymer of the Matyjaszewski reference in both water and organic solvent as inherent as an inherent property is improper – as such an "inherent" property relates to the level of hydrophilic monomer, as well as the Tg and percentages, and the Matyjaszewski reference teaches or suggests no level of hydrophilic monomer – other than zero from all examples teaching away, and silence of the need for any hydrophilic monomer – much less any of those claimed in Applicant's amended claims..

Matyjaszewski in view of Farct

Claims 7, 9, and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Matyjaszewski et al. J. Phys. Org. Chem. , 2000, 13, p. 775-786, in view of Farct et al. "Nitroxide-mediated mini-emulsion polymerization of n-butyl acrylate: synthesis of controlled homopolymers and gradient copolymers with styrene".

As discussed above, the Matyjaszewski reference fails to teach or suggest a required specific hydrophilic monomer at the level required by Applicant's claims, as amended. The Farct reference is a secondary reference cited for its disclosure of specific nitroxides in mini emulsions. The Farct reference also fails to teach or suggest a required specific hydrophilic monomer at the level required by Applicant's claims, as amended, and therefore fails to heal the deficiencies of the Matyjaszewski reference.

Nesvada

Claims 1, 2, 4-7, 9,10, 13, and 17-20 and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable as obvious over Nesvadba et al. (U.S. Patent 6,262,206). The Nesvadba reference fails to teach or suggest all of Applicant's claim limitations, thus fails to provide a *prima facie* case of obviousness. Specifically, the Nesvadba reference fails to teach or suggest Applicant's specific COMBINATION of gradient copolymer, monomer % and Tgs; and where the copolymer is soluble or dispersible in both water and in organic solvents.

The Examiner is confusing the polymerization of monomers in water or organic solvent, with the property of the gradient copolymer itself being soluble in water or organic solvent at a concentration greater than or equal to 5%. Processes for forming a polymer by solution, emulsion or suspension polymerization are well-known. The polymer can be made to stay suspended or dispersed by using stirring, cosolvents and dispersing aids (or emulsifiers). However, while the polymers may be suspended – they are not soluble in the suspending agent. The Nesvada reference even points to the use of cosolvents or surfactants for forming the polymer (Col. 9, lines 64-67), and these prevent the precipitation or phase separation of the reactants or polymer products until after the polymerization reactions (Col. 10, lines 19-21). A suspension by chemical or physical means is NOT the same as a solution! The Nesvadba reference does not teach or describe a gradient polymer soluble at least 5% in both water and organic solvent.

The Examiner's fall-back position is that the dual solubility would be an inherent property of copolymers in the Nesvada reference – since the Nesvada wash lists of monomers includes monomers falling within each of Applicant's required elements. The Nesvada structures include homopolymers, random copolymers, block, star and gradient copolymers (Col. 12, lines 56-58).

But there is no teaching or suggestion of a gradient copolymer that requires at least two different monomers, with at least 50% by weight having a Tg <20°C, and a monomer having a Tg >20°C, where at least 10% is a hydrophilic monomer, at the right Mn and Mw, and using the specific monomers of Applicant's amended claims. The Nesvada teaching encompasses every type of polymer architecture, and most possible monomers. Applicant's invention could be considered a selection invention, in which specific parameters were selected to obtain a gradient copolymer of higher molecular weight that is soluble in both water and solvent at 5% or greater. There is no teaching or suggestion in the Nesvada reference to even try to obtain such a special copolymer – yet many, many teachings of homopolymers and copolymers that fall outside of Applicant's narrow claims. Since the Nesvada reference fails to teach or suggest with any specificity a gradient copolymer having Applicant's claimed composition, the copolymers taught and suggested by Nesvada would not have the same inherent properties.

Further, none of the many Nesvadba Examples exemplify Applicant's claimed copolymer

(meaning all of the examples teach away from Applicant's claims

Every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by applicant. *In re Kotzab*, 55 U.S.P. Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted).

Applicant's invention relates to the field of amphiphilic gradient copolymers that are soluble in water as well as in organic solvents. (Specification, page 1, lines 13-15). Since the solubility of a copolymer in water and solvent was not recognized as a result to achieve in the '206 patent, the composition could not be optimized through routine experimentation to obtain such a result.

In view of the above, the Applicant believes that the reasons for rejection have been overcome, and the claims herein should be allowable to the Applicant. Accordingly, reconsideration and allowance are requested.

Respectfully submitted;



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